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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,295	04/14/2004	Christopher J. Grubb	W200401	6057

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EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,295

Applicant(s)

GRUBB, CHRISTOPHER J.

Examiner

Pierre E. Elisca

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicant's amendment filed on 05/04/2006.
2. Claims 1 and 3-15 are pending. Claims 2 and 16-35 are cancelled.
3. The rejection to claims 1 and 3-15 under 35 U.S.C. 103 (a) as being unpatentable over Conklin, Cole in view of Barker as set forth in the office action mailed on 3/14/2006 is maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 3-15 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Conklin et al (U.S. Pat. No. 6,141,653) and **Cole et al US 2002/0161707 A1** in view of Barker et al (U.S. Pat. No. 5,931,916).

As per claims 1, 3, 4, 6-9, and 11-15 Conklin substantially discloses a multivariate negotiations engine for iterative bargaining which enables a sponsor to create and administer a community between participants such as buyers and sellers having similar interests, the system comprising:

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A user input module configured to operate on a first computer station located at a first location and communicate with a database (see., abstract, figs 1a,1b, and 1n, col 17, lines 13-67, col 18, lines 1-67, col 19, lines 1-67, col 20, lines 1-67, col 21, lines 1-57); Said user input module being further configured to receive an input from users (see., abstract, figs 1a,1b, and 1n, col 17, lines 13-67, col 18, lines 1-67, col 19, lines 1-67, col 20, lines 1-67, col 21, lines 1-57);

A sale negotiation module configured to communicate with the first location and database, and achieve a sale price for the item (see., col 8, lines 49-62);

A generator module configured to request and provide a readable medium to the user at the first location and to communicate with the database (see., abstract, figs 1a,1b, and 1n, col 17, lines 13-67, col 18, lines 1-67, col 19, lines 1-67, col 20, lines 1-67, col 21, lines 1-57);

Said medium including computer readable codes matched to the input with a scanner operable to autonomously read the codes (see., abstract, col 7, lines 59-64, specifically electronic signature or certificate, it obvious to realize that figs 1a-1n can also include a scanner to read the codes). Conklin fails to explicitly disclose wherein said tracking the delivery item. However, **Cole discloses a system/method for tracking an item using FEDEX. Once a seller 14 enters an input that the item was shipped by FEDEX with the tracking number which FEDEX provides the shipper, the system actually goes to FEDEX on an automated basis on a regular schedule and requests the status of the shipment from FEDEX. FEDEX automatically provides this information to**

the system, and a report of the status is made available to both buyer 12 and seller 14 (see., abstract, 26 [0202] - [0204].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the multivariate negotiations of Conklin by including the limitation detailed above as taught by Cole because this would allow seller and buyer to track the delivery of an item.

Conklin and Cole fail to disclose the limitation wherein said module configured to request and provide to the user **within a maximum period**. Barker discloses a method for retransmitting data to a destination. A RDP module forwards any confirmation of delivery of a datagram to a user at a maximum time (see., col 7, lines 43-67, col 9, lines 22-45). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Conklin and Loeb by including the limitation detailed as taught by Barker because this would indicate when there is an error in the communication attempt at a particular destination.

As per claim 2, Conklin discloses the claimed limitation wherein said a receiver input module accessible at a second location and configured to communicate with the database, said receiver input module being further configured to produce a delivery indicator (see., abstract, figs 1a,1b, and 1n, 17, lines 13-67, col 18, lines 1-67, col 19, lines 1-67, col 20, lines 1-67, col 21, lines 1-57).

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As per claim 5, Conklin discloses the claimed limitation wherein said medium being stored in the record (abstract, figs 1a,1b, and 1n, col 17, lines 13-67, col 18, lines 1-67, col 19, lines 1-67, col 20, lines 1-67, col 21, lines 1-57).

As per claim 10, Conklin discloses the claimed limitation wherein said network comprising a plurality of interconnected networks hosting a plurality of computer workstations (see., figs 1a-1n).

RESPONSE TO ARGUMENTS

6. Applicant's arguments have been fully considered but they are not persuasive.

REMARKS

7. In response to Applicant's arguments, Applicant argues that the prior art of record (Conklin et al , **Cole et al US 2002/0161707** A1 in view of Barker) fail to disclose the recited feature:

a. " The Examiner must satisfy three criteria in order to establish the requisite prima facie of obviousness". However, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In *re* Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In *re* Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In *re* Eli Lilli & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In *re* Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte* Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter); and *Es parte* Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to *Ex parte* Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In *re* Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In *re* Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

b. " Conklin does not disclose a computer readable medium for affixing to an item, and the tracking of that item". The Examiner respectfully disagrees with this assertion since Cole discloses a system/method for tracking an item using FEDEX. Once a seller 14 enters an input that the item was shipped by FEDEX with the tracking number which FEDEX provides the shipper, the system actually goes to FEDEX on an automated

basis on a regular schedule and requests the status of the shipment from FEDEX. FEDEX automatically provides this information to the system, and a report of the status is made available to both buyer 12 and seller 14 (see., abstract, 26 [0202] - [0204].

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571 272 6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Pierre Eddy Elisca

Primary Patent Examiner

July 19, 2006